

Serial No. 09/916,679  
Docket No. YOR920000305US1

9

### REMARKS

Claims 1-10, 12-15, 17, 18, 42 and 44-56 are all the claims presently pending in the application. Claims 45-51 and 53-56 have been withdrawn as allegedly directed to a nonelected species. Claim 11 has been canceled. Claims 1 and 52 have been amended to more particularly define the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 2-3 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Claims 1-10, 12-15, 17, 18, 42, 44 and 52 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Walker et al. (U.S. Patent No. 6,356,878) in view of Fisher et al. (U. S. Pat. No. 6,243,691). Claims 1-15, 17, 18, 42, 44 and 52 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the alleged admitted prior art (APA) in view of Walker and Fisher.

These rejections are respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention (e.g., as recited in claim 1) is directed to a system for buying and selling merchandise. The system includes a network including a plurality of user terminals, a memory device for storing a predetermined event for the merchandise, and at least one processor, accessible by the plurality of user terminals, for automatically adjusting a price of the merchandise upon an occurrence of the predetermined event, and matching a buyer with the merchandise to facilitate a transaction. Further, the network includes the Internet, the memory device and the at least one processor being included in a seller website which is accessible via the Internet. The processor generates a document which is stored in the memory device and includes an adjusted price of the merchandise, the document being viewable by using a web browser on

Serial No. 09/916,679  
Docket No. YOR920000305US1

10

one of the plurality of user terminals.

Importantly, the processor calculates a quantity of merchandise to be purchased on a particular date based on an expiration date for that merchandise and a consumption rate for the merchandise, to minimize a total price for the merchandise (Application at page 11, lines 1-9).

Conventional systems do not adjust (e.g., automatically adjust) a price of merchandise or generate a document (e.g., including an adjusted price of the merchandise) which is viewable by using a web browser on one of the plurality of user terminals).

The claimed invention, on the other hand, includes a processor calculates a quantity of merchandise to be purchased on a particular date based on an expiration date for that merchandise and a consumption rate for the merchandise, to minimize a total price for the merchandise (Application at page 11, lines 1-9). That is, unlike conventional systems, the claimed invention may determine (e.g., and conveniently recommend to the buyer) a quantity of merchandise to be purchased on a particular date in order to minimize an overall price to the buyer.

## II. THE 35 USC §112, SECOND PARAGRAPH REJECTION

Claims 2-3 stand rejected under 35 U.S.C. §112, second paragraph. Applicant respectfully disagrees with the Examiner.

The Examiner surprisingly alleges that claims 2 and 3 do not further limit the claimed invention. Applicant respectfully submits that this is nonsense.

Indeed, Applicant would point out that claim 1 recites "merchandise" which may include for example, only non-time-sensitive merchandise. However, claim 2 further limits the merchandise to including "*time-sensitive merchandise*".

Further, claim 1 recites a "predetermined event" which may include, for example, only items unrelated to a decrease of an expiration period. However, claim 3 further limits the predetermined event to include "a decrease of an expiration period".

Applicant is surprised by the Examiner assertion that these limitations of claims 2 and 3 do not further limit claim 1. Indeed, the Examiner's assertion is completely unreasonable.

Serial No. 09/916,679  
Docket No. YOR920000305US1

11

The Examiner implies that the limitations of claims 2-3 are "mere price adjustments". Applicant is utterly confused by this assertion. Indeed, Applicant fails to see how a limitation that recites "time sensitive" or a "decrease of an expiration period" has anything to do with a "price adjustment". Thus, if the Examiner persists in this unreasonable rejection, the Examiner must explain this confusing statement to allow Applicant an opportunity to make a reasoned response.

Therefore, contrary to the Examiner's allegations, claims 2-3 are clear and not indefinite.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### III. THE ALLEGED PRIOR ART REFERENCES

#### A. Walker and Fisher

The Examiner alleges that Walker would have been combined with Fisher to form the invention of claims 1-10, 12-15, 17, 18, 42, 44 and 52. Applicant submits, however, that these alleged references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Walker '268 discloses a system for providing a restaurant menu, in which a price is automatically determined based at least partly on revenue management information.

Fisher discloses a system for conducting an interactive auction. The system includes a "markdown" feature which may periodically adjust a price for merchandise.

Applicant respectfully submits that these references would not have been combined as alleged by the Examiner. Indeed, these references are unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, contrary to the Examiner's allegations, neither of these references teach or suggest their combination.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would not

Serial No. 09/916,679

12

Docket No. YOR920000305US1

have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Walker, nor Fisher, nor any alleged combination of these references teaches or suggests *"wherein said processor calculates a quantity of said merchandise to be purchased on a particular date based on an expiration date for said merchandise and a consumption rate for said merchandise, to minimize a total price for said merchandise"*, as recited, for example, in claims 1 and 52.

As noted above, unlike conventional systems, the claimed invention includes a processor calculates a quantity of merchandise to be purchased on a particular date based on an expiration date for that merchandise and a consumption rate for the merchandise, to minimize a total price for the merchandise (Application at page 11, lines 1-9). That is, unlike conventional systems, the claimed invention may determine (e.g., and conveniently recommend to the buyer) a quantity of merchandise to be purchased on a particular date in order to minimize an overall price to the buyer.

Clearly, this novel feature is not taught or suggested by the cited references. Indeed, the Examiner implicitly concedes that Walker does not teach or suggest this feature, but alleges that it is disclosed by Fisher. The Examiner is incorrect.

Indeed, the Examiner attempts to support his rejection of claim 11, which recited a similar limitation, by asserting that "Fisher discloses: Progressive Auction, and Mark Down formats each or which is time based and insures maximum depletion of inventory for top price" (Office Action at page 8). However, even assuming that Fisher discloses these features, Fisher still does not teach or suggest processor that calculates a quantity of merchandise to be purchased on a particular date based on an expiration date for that merchandise and a consumption rate for the merchandise, to minimize a total price for the merchandise.

For example, as explained in the background section of the Application, assume that a consumer who eats two bananas a week is looking to buy a pound of bananas. If the consumer pays \$1.00 per pound for bananas with a 3-week shelf life, the effective cost to the consumer is \$0.17 per banana, whereas if he pays \$0.50 per pound of bananas with a 1-week shelf life, the

Serial No. 09/916,679

13

Docket No. YOR920000305US1

effective cost is \$0.25 per banana (Application at page 4, lines 6-11). That is, although the price per pound may be decreased (i.e., from \$1.00 to \$0.50), the overall price to the consumer may be greater when the bananas are sold at the reduced price.

The claimed invention, however, may help the consumer to know when and how much of the merchandise to buy in order to minimize the overall price. That is, the processor calculates a quantity of merchandise to be purchased on a particular date based on an expiration date for that merchandise and a consumption rate for the merchandise, to minimize a total price for the merchandise. Nowhere is this feature taught or suggested by Fisher.

Indeed, Fisher merely discloses marking down the price periodically until the "available quantity is purchased" (Fisher at col. 12, line 5). In fact, **Fisher is only interested in the seller's perspective and does not show any interest in providing any benefit to the consumer.** This is contrary to the claimed invention, which may include features for assisting the consumer to purchase, for example, an appropriate quantity on an appropriate date, in order to help ensure that the buyer is making a smart purchase. Thus, Fisher clearly does not make up for the deficiencies of Walker.

Therefore, Applicant submits that these alleged references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

#### **B. The Alleged APA**

The Examiner alleges that the Alleged APA would have been combined with Walker and Fisher to form the invention of claims 1-15, 17, 18, 42, 44 and 52. Applicant submits, however, that these alleged references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

The Alleged APA (e.g., Application at Figure 1) discloses a negotiation system 150 in which a participant 140 may propose terms to another participant over the Internet.

Applicant respectfully submits that these references would not have been combined as

Serial No. 09/916,679  
Docket No. YOR920000305US1

14

alleged by the Examiner. Indeed, these references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

In fact, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, contrary to the Examiner's allegations, neither of these references teach or suggest their combination.

Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither the alleged APA, nor Walker, nor Fisher, nor any alleged combination of these references teaches or suggests "*wherein said processor calculates a quantity of said merchandise to be purchased on a particular date based on an expiration date for said merchandise and a consumption rate for said merchandise, to minimize a total price for said merchandise*", as recited, for example, in claims 1 and 52.

Clearly, this novel feature is not taught or suggested by the alleged APA. Indeed, the Examiner attempts to rely on Figure 1 of the present Application to support his position. However, the Examiner is clearly incorrect.

Indeed, Figure 1 merely depicts a conventional system 100 for buying and selling merchandise. The Application explains that the system 100 does not automatically adjust a price of merchandise upon the occurrence of a predetermined event. Indeed, **the Examiner concedes this in the Office Action at page 7.**

Thus, certainly the alleged APA does not teach or suggest a processor that calculates a quantity of merchandise to be purchased on a particular date based on an expiration date for that merchandise and a consumption rate for the merchandise, to minimize a total price for the merchandise. Thus, the alleged APA clearly does not make up for the deficiencies of Walker and Fisher.

Therefore, Applicant submits that these alleged references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every

Serial No. 09/916,679  
Docket No. YOR920000305US1

15

element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

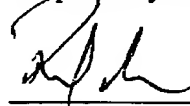
#### IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-10, 12-15, 17, 18, 42 and 44-56, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: 10/25/05

Phillip E. Miller, Esq.  
Registration No. 46,060

McGinn IP Law Group, PLLC  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
Customer No. 21254

#### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Joseph A. Fischetti, Group Art Unit # 3627 at fax number 571-273-8300 this 25th day of October, 2005.



Phillip E. Miller  
Reg. No. 46,060